

III. REMARKS

Status of the Claims

Independent claims 1, 13, 25, 29, and 33 are amended. Claims 1-36 are presented for further consideration. Applicant is pleased to note that claims 10, 11, 22, and 23 are indicated to contain patentable subject matter.

Applicant has considered the Examiner's comments set forth in the Office Action mailed August 11, 2008 and responds in detail below. Reconsideration of the application is respectfully requested in view of the amendments and the following remarks.

The Office Action

Claim 33 is amended, according to the Examiner's suggestion, to overcome the rejection under 35 USC 101 raised by the Examiner in paragraph 3 of the Office Action.

In paragraph 4 of the office action, claims 1-9, 12-21 and 24 stand rejected under 35 U.S.C. 103(a) based on the combined teaching of the reference Durrett, U.S. Patent No. 9,964,830 and Official Notice. This rejection is traversed on the following grounds:

The combined teaching does not render claims 1-9, 12-21 and 24 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)*. See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

In particular the combined teaching fails to disclose or suggest the following claimed features of independent claim 1, as amended:

" a plurality of mobile terminals, each being provided with an application for using personal content, and a transmitter and receiver for wireless communication with a telecommunications system, said personal content including at least one of photographs, text, video, speech, calendar information, and location information;

a memory in the mobile terminal for storing at least a first part of the personal content to be used;

at least one remote data repository connected to the telecommunications system for storing at least a second part of the personal content to be used, wherein at least one of the repositories is assigned for the use of each mobile terminal;

said application further being adapted for selecting said at least a second part of the personal content and transferring it between the memory and the at least one remote data repository through said telecommunications system, the application including predetermined criteria, the fulfilment of which, initiates said transfer;

an extraction block for extracting data from said at least a first part of the personal content and an association block for associating said extracted data with said at least a second part of the personal content; and

a service provision block responsive to said association block to generate and/or provide a personalized service incorporating a combination of the first part of the personal content and the second part of the personal content which have been associated with each other by the association block."

Independent claims 13, 25,29, and 33 as amended.,

It would appear from the official action that the Examiner considers the encryption keys, user ID and password disclosed in Durrett to constitute, at least in part the personal content of applicant's claims. Although not explicitly stated, it would appear that the Examiner considers the encryption keys, user ID and password to constitute personal content in the form of text, as it is also clear that the encryption keys, user ID and password do not constitute photographs, video, speech, calendar information or

location information. Applicant submits that this is a misinterpretation of both the content of the cited reference and the subject matter claimed in this application.

The so-called encryption data of Durrett is used, according column 5, lines 45-51, of Durrett, as follows:

"Logging into the access provider computer and for activating local computer 10A is accomplished via fingerprint key 13A. Fingerprint key 13A scans the user's fingerprint and correlates this to a file which is stored within the non-volatile memory of the access provider computer. In one embodiment, the fingerprint" data serves as a "key" to de-crypt the data stored within the non-volatile memory."

The encryption key of Durrett is used to obtain access to files stored in the memory of a remote server. There is nothing in Durrett that discloses or suggests that an application stored in a mobile terminal may select a second part of personal data from a remote data repository and combine it with another part of a personal data file stored in memory of a mobile telephone to obtain services that use the combined information.

Applicant, therefore, respectfully submits that the Examiner is mistaken in stating that Durrett discloses a service provision block adapted to provide a personalized service incorporating the combined information according to the claims of this application as amended. The encryption keys, user ID and password disclosed in Durrett are used to identify the user to the virtual disc server. After successful notification the user is allowed access to the virtual disc server such that software saved on the virtual disc server can be used to provide a service to the user. However, the service provided to the user does not incorporate the encryption keys, user ID and password as suggested by the Examiner. Rather, the encryption keys, user ID and password are only used to access the software which provides a service to the user. They are not used in the application. Accordingly, the combined teaching of the reference Durrett and official notice fails to teach or suggest the use of a mobile terminal as described in the independent claims of this application. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the

independent claims. None of the cited references remedy the deficiencies of the primary reference Durrett.

The Examiner further characterizes the disclosure of Durrett as follows:

“.....other portions of personal content such as newly scanned fingerprint, user ID password must be temporarily stored in local memory before they are being processed and or transmitted.”

This is an assumption by the Examiner that is unsupported by Durrett, as is indicated in the above excerpt (also see Durrett at column 6, lines 9-12 and further at column 6, lines 25-29). The non-volatile memory of the access provider is not within local computer 10B. The scanned fingerprint data is input to the access provider. Whether or not this data is momentarily stored in the local computer is speculation on the part of the Examiner and contrary to the teaching of Durrett.

In paragraph 14, claims 13-21, 24-26,29-30 and 33-36 are rejected under 35USC103(a) based on the teaching of the reference Durrett, on the same grounds as indicated in paragraph 4 of the office action. This rejection is traversed on the following grounds:

The combined teaching of Durrett does not render claims 13-21, 24-26,29-30 and 33-36 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a *prima facie* case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

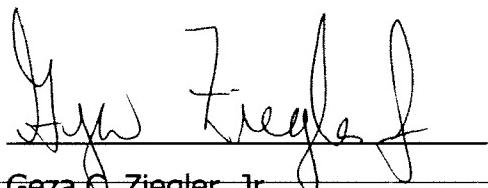
In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1,13, 25, 29, and 33 as indicated above. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims.

Applicant has carefully reviewed the Examiner's helpful response to previous arguments presented by Applicant and the independent claims of this application are amended to clearly support the above arguments. In particular, it is now clear that the personalized service uses a combination of the personal content stored in the mobile terminal and the personal content stored in the remote repository as associated with each other by the association block. Durrett fails to teach this feature.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza G. Ziegler, Jr.
Reg. No. 44,004

10 Nov 2008

Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512